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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/032,751	10/27/2001	Vijay Vaidyanathan	1104-031	5799

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EXAMINER	
JABR, FADEY S	

ART UNIT	PAPER NUMBER
3639	

DATE MAILED: 03/23/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/032,751	VAIDYANATHAN ET AL.	
	Examiner	Art Unit	
	Fadey S. Jabr	3639	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *12 January 2006*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-40* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-40* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Status of Claims

Claims **1-40** remain pending and are again presented for examination.

Response to Arguments

1. Applicant's amendment filed 12 January 2006, with respect to the Objection of the specification, has been withdrawn due to Applicant's amendment.

2. Applicant's arguments filed 12 January 2006, with respect to rejections under 35 U.S.C. section 103 as being unpatentable over Kopelman et al. have been fully considered and are not persuasive.

3. Applicant's arguments filed 12 January 2006 have been fully considered but they are not persuasive. In response to applicant's argument (with respect to claims 1, 2-13, 15-20, and 23-40) that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, one of ordinary skill in the art would have been led to modify Kopelman et al. in view of the fact that Kopelman et al. discloses compensating (reseller commission) the marketplace for facilitating the sale. Therefore, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the method Kopelman et al. and include basing the payment to the content

owner on the sale price and the reseller commission, because the content owner utilizes the marketplace which facilitates the sale of the goods and therefore the content owner must compensate the marketplace.

4. Applicant argues (with respect to claims 1, 3, 12, 23, 24, 33 and 34) that Kopelman et al. does not disclose other users download the files on the marketplace and become resellers, which Applicant calls element b. Examiner notes that element b states allowing a first user to search for files posted on the digital marketplace. Kopelman et al. discloses allowing a buyer to browse the content listed on the marketplace (Para.20). Kopelman et al. teaches a marketplace which is a reseller of the content owner's goods. Kopelman et al. also discloses that the marketplace can be a conventional type storefront, in a conventional type storefront goods can be bought directly from the store (Para. 26).

5. Applicant's arguments filed 12 January 2006 have been fully considered but they are not persuasive. In response to applicant's argument (with respect to claims 2, 12, 14, 21 and 22) that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, one of ordinary skill in the art would have been led to combine Kopelman et al. and Kasriel et al. in view of the fact that Kasriel et al teaches that their invention has general applicability and can be used for requesting information from servers. Therefore, it would have been obvious to one of ordinary skill in the art at the time

of applicant's invention to modify the method of Kopelman et al. and include allowing content owner's to monitor download statistics, because it allows the content owner to examine which goods are being sold.

6. Applicant's arguments filed 12 January 2006 have been fully considered but they are not persuasive. In response to applicant's argument (with respect to claims 2, 13, 14, 21 and 22) that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, one of ordinary skill in the art would have been led to modify Kopelman et al. in view of the fact that Kopelman et al. discloses compensating (reseller commission) the marketplace for facilitating the sale. Therefore, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the method Kopelman et al. and include basing the payment to the content owner on the sale price and the reseller commission, because the content owner utilizes the marketplace which facilitates the sale of the goods and therefore the content owner must compensate the marketplace.

7. Applicant argues (with respect to claims 2, 13 and 14) that Kopelman et al. does not disclose monitoring download statistics. Examiner notes that Kasriel et al. teaches pre-download statistics. Pre-download statistics are statistics, which are to be downloaded prior to the user

actually requesting the files, and are therefore still statistics on the requested files (Col. 2, lines 56-59).

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

2. Claims **1, 3-12, 15-20, 23-40** are rejected under 35 U.S.C. 103(a) as being unpatentable over Kopelman et al., Pub. No. US2004/0138966 A1.

As per **Claims 1, 3, 12, 23, 24, 33 and 34**, Kopelman et al. discloses a method for providing an online digital marketplace, the digital marketplace having a plurality of digital files for access by consumers over a network, the method comprising the steps of:

(a) allowing a content owner to post a file on the marketplace for access by users by (Para. 26, lines 6-8; Para. 37, lines 10-11),

- (i) providing information about the file (Para. 26, lines 12-16; Para. 39),
- (ii) setting a retail price that users will be charged for downloading the file (Para. 25),

(b) allowing a first user to search for files posted on the digital marketplace for one to resell on a third party website (Para. 20);

(c) allowing a second user to search the files posted on the digital marketplace for one to download (Para. 27, lines 1-2);

(d) if the second user selects a particular file to download, charging the user the retail price set for the file (Para. 28, lines 11-20);

(e) if the second user downloads the particular file from the third party website, paying the first user the reseller commission set for the file(Para. 20, lines 8-12; Para. 28, lines 26-27);

(g) allowing the content owner to edit the file information and to change the retail price and the reseller commission in real-time (Para. 43, lines 10-14).

Kopelman fails to explicitly disclose setting a reseller commission and base the payment to the content owner on the retail price and the set reseller commission. However, Kopelman discloses paying the seller a predetermined value for their goods and compensating the marketeer for facilitating the transaction (Para. 25, lines 3-12; Para. 28, lines 26-27). Therefore, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the method of Kopelman and include paying the owner of the goods a price minus a reseller commission for the file, because compensating the reseller a set commission for facilitating the transaction would greatly increase the profitability of the digital marketplace.

As per **Claims 4 and 15**, Kopelman et al. discloses al of the limitations in claims 1, and 12. Kopelman fails to explicitly disclose allowing the content owner to set the retail price and the reseller commission both positively and negatively. However, Kopelman discloses setting the retail price for the good and compensating the marketeer for the transaction (Para. 25; Para.

28, lines 26-27). Therefore, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the method of Kopelman et al. and include either increasing or decreasing the retail price and the reseller commission, because adjusting the price and commission would entice resellers and buyers to sell and purchase more goods, respectively.

As per **Claims 5, 16, 25, 30, 35, and 40**, Kopelman et al. discloses a method in which the retail price for the goods are determined by a price index which the seller chooses (Para. 25). However, Kopelman et al. fails to explicitly disclose implementing at least six pricing models for file downloads within the digital marketplace, including a pay-per-download a model, a subscription model, a broadcast model, a private download model, a donation, and an infomercial model.

Official notice is taken that several pricing models can be put into practice in any marketplace is old and well known in the art. Therefore, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the method of Kopelman et al. to include the above pricing models because, Kopelman et al. teaches allowing the seller to choose a retail price based on a price index (Para. 25). One of ordinary skill in the art would be motivated to do so, because it provides the user with a system that is user friendly by allowing the user to choose a pricing model that best suits their frequency of use.

As per **Claims 6, 17, 26, and 36**, Kopelman et al. further discloses a method requesting the first user to enter display options for the search (Para. 37, lines 16-19).

As per **Claims 7, 18, 27, and 37**, Kopelman et al. further discloses a method including as the display options showing free files, pay-per-download files, or files listed as resalable (Para. 37, lines 16-19).

As per **Claims 8, 19, 28, and 38**, Kopelman et al. further discloses a method requesting the first user to enter sorting options for the search (Para. 37, lines 10-19).

As per **Claims 9, 20, 29, and 39**, Kopelman et al. further discloses a method including as the sorting options sorting the matching files by popularity, by date, by size, by price, and by the reseller commission (Para. 37, lines 16-19).

As per **Claim 10 and 31**, Kopelman et al. further discloses a method implementing the digital marketplace as a website on a network (Para. 29, lines 5-9).

As per **Claim 11 and 32**, Kopelman et al. further discloses a method implementing the digital marketplace as a peer-to-peer network (Para. 14).

3. Claims **2, 13, 14, 21, and 22** are rejected under 35 U.S.C. 103(a) as being unpatentable over Kopelman et al., Pub. No. US2004/0138966 A1 in view of Kasriel et al., U.S. Patent No. 6,721,780 B1.

As per **Claims 2, and 13**, Kopelman et al. discloses all of the limitations in claims 1 and 12. Kopelman et al. discloses a method to change the retail price and the reseller commission for the file in real-time (Para. 43, lines 10-14). Kopelman et al. fails to disclose a method allowing the content owner to monitor download statistics for the file the content owner posted. However, Kasriel et al. teaches allowing a user to track statistics on downloading (Col. 4, lines 36-46). Therefore, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the method of Kopelman et al. and include allowing a content owner to monitor download statistics as taught by Kasriel et al. Kasriel et al. provides motivation by explaining tracking the statistics would allow a user to examine the statistics in order to greatly improve the efficiency of the system.

As per **Claim 14**, Kopelman et al. fails to explicitly disclose a method generating revenue for the digital marketplace by subtracting a transaction fee from the payment made to the content owner. However, Kopelman et al. discloses compensating the marketeer for facilitating the transaction (Para. 28, lines 26-27). Therefore, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the method of Kopelman et al. and include a payment to the content owner less the transaction fee, because compensating the reseller a set commission for facilitating the transaction would greatly increase the profitability of the digital marketplace.

As per **Claims 21**, Kopelman et al. further discloses a method implementing the digital marketplace as a website on a network (Para. 29, lines 5-9).

As per **Claims 22**, Kopelman et al. further discloses a method implementing the digital marketplace as a peer-to-peer network (Para. 14).

Conclusion

4. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Fadey S. Jabr whose telephone number is (571) 272-1516. The examiner can normally be reached on Mon. - Fri. 7:30am to 4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Hayes can be reached on (571) 272-6708. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Fadey S Jabr
Examiner
Art Unit 3639

FSJ

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JOHN W. HAYES
SUPERVISORY PATENT EXAMINER